

SUPPORT FOR THE AMENDMENTS

Claims 3 and 8 were previously canceled.

Claims 1, 2, 4, and 7 have been amended.

The amendment of Claims 1, 2, 4, and 7 is supported by the corresponding previously pending claims and the original specification as filed, for example at page 1, line 10 to page 2, line 8, page 12, line 16 to page 13, line 4, page 16, line 24 to page 17, line 11, and the Examples.

No new matter has been entered by the present amendment.

REMARKS

Claims 1, 2, 4-7, 9, and 10 are pending in the present application.

At the outset, Applicants note that the Notice of Non-Compliant Amendment mailed March 25, 2008, is incorrect for much of the same reasons the Notice of Non-Compliant Amendment mailed on July 10, 2006 was. Just as the Notice of Non-Compliant Amendment mailed on July 10, 2006, was withdrawn, so too should the Notice of Non-Compliant Amendment mailed March 25, 2008.

In the Notice of Non-Compliant Amendment mailed March 25, 2008, the Examiner alleges “In accordance with the 04 November 2004 response to the restriction requirement, applicant elected prime[r] pair corresponding to SEQ ID NO: 7 and SEQ ID NO: 8, and methods using the same (claims 1-4, 7, and 8). As presently worded, the method of claims 1 and 4 are not so limited, yet they are not identified as being withdrawn from consideration.”

Applicants disagree with the Examiner’s position in this regard. First, Applicants submit that Claim 1 is generic to the elected invention. Second, Claim 4 was indicated as withdrawn in the response filed on May 7, 2007, but on page 2 paragraph 1 of the Office Action mailed June 19, 2007, the Examiner indicated that Claim 4 was generic to the elected invention. Further, the Examiner actually examined and rejected Claim 4 (see paragraph 5 on page 3 and paragraph 13 on page 11, of the Office Action mailed June 19, 2007).

Further, with respect to Claim 1, the Examiner is reminded that the Office Communication mailed October 4, 2004, the Office required an *election of species* as follows:

Species I: a pair of primers including SEQ ID NOs: 7 and 8, and methods of
 employing that pair of primers (e.g., claims 2-3 and 7-8), and

Species II: a pair of primers including SEQ ID NOs: 9 and 10, and methods of employing that pair of primers (e.g., claims 5-6 and 9-10).

In making this election of species requirement, the Examiner acknowledged that Claims 1 and 4 are generic (see MPEP §806.04(d) for definition). Further, it was acknowledged that “upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.”

In Claim 1, the first primer is defined as being the sequence of SEQ ID NO: 7, while the second primer is defined as a “primer consisting of 15-30 nucleotides of a sequence that is complementary to a base sequence of chromosome IX of *Saccharomyces cerevisiae* located downstream from a sequence selected from the group consisting of SEQ ID NO: 1, SEQ ID NO: 2, SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 5, and SEQ ID NO: 6” (see Claim 1). Claim 1 remains generic to the elected species of SEQ ID NO: 8. In fact, the Examiner recognizes as much in the Notice of Non-Compliant Amendment mailed July 10, 2006 (lines 5-6 of the Continuation of 4(e)).

With respect to the Examiner’s criticism that “As presently worded, the method of claims 1 and 4 are not so limited, yet they are not identified as being withdrawn from consideration”, Applicants submit that there is nothing in the rules that prohibit the scope of a claim from being broader than the elected species, much as there is no requirement that Applicant must narrow the scope of a generic claim to the specifically elected species by excluding any and all other members of the genus. Yet, this is the sole basis offered by the Examiner in the Notice of Non-Compliant Amendment with respect to Claim 1. Applicants submit that the contrary of the Examiner’s assertion is correct. Upon a finding of allowability of the elected species the Office should expand its search to the non-elected species embraced

by the claimed genus. Therefore, it is absolutely proper to maintain the generic claim. This is especially true where the scope of the genus is largely unchanged or is narrowed with respect to the genus that was subject to the original election of species requirement.

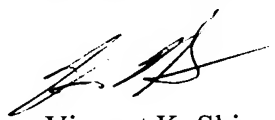
The only way in which Claim 1 as presented in the response filed on November 19, 2007, could be non-compliant is if the claims were amended to exclude the elected species (i.e., SEQ ID NO: 8) from the scope of the pending claims. This is not the case here. Therefore, the response filed on November 19, 2007, is fully compliant with respect to Claim 1.

With respect to Claim 4, Applicants remind the Examiner that this claim has been examined. As indicated above, in paragraph 1 on page 2 of the Office Action mailed June 19, 2007, the Examiner indicated that Claim 4 was generic to the elected invention. Even if this were not the case, the Examiner *examined and rejected* Claim 4 (see paragraph 5 on page 3 and paragraph 13 on page 11, of the Office Action mailed June 19, 2007). Certainly, where the claim had already been examined it is not possible to maintain that a serious burden on the Examiner exists. Further, the indication in paragraph 1 on page 2 of the Office Action and the subsequent examination and rejection of Claim 4, clearly indicates that the election of species requirement over this claim had been withdrawn. Therefore, the response filed on November 19, 2007, is fully compliant with respect to Claim 4. Nonetheless, Applicants have changed the identifier for this claim to “withdrawn; currently amended”.

Applicants submit that the present application is now in condition for further examination. It is respectfully requested that the Office acknowledge such action without any further needless delay. Early notification of such action is earnestly solicited.

Respectfully submitted,

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